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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,663	09/03/2003	Corinne Bortolin	16222U-015900US	5371
20350	7590	12/17/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ST CYR, DANIEL	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/654,663	BORTOLIN ET AL.	
	Examiner Daniel St.Cyr	Art Unit 2876	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-46 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/17/04</u> .	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 6, 9-15, 17, 19, 30, 31, 34-37, 39, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Drupsteen, US Patent No. 6,073,238, cited by the applicant.

Drupsteen discloses a method of securely loading commands in a smart card comprising: a body 2; and a computer readable medium 12 coupled to the body, the computer readable medium comprising a data string MC1, MC2, MC3, MC4 including one or more wildcard values, wherein the data string is specifically associated with the consumer; and a card reader serving as an access device. (see figures 1-3, and col. 3, line 34 to col. 5, line 16).

Re claims 2, 31, 34, 35, and 46, wherein the portable consumer device is a smart card, and wherein the computer readable medium is in the form of an integrated circuit. (see figures 1-2).

Re claims 4, 37, and 39, wherein the data string2 including one or more wildcard values encompasses identification codes for two or more different products (applications) (see col. 5, lines 14-16).

Re claim 6, wherein the data string including one or more wildcard values encompasses two or more values (see col. 5, lines 14-16).

Re claim 7, wherein the portable consumer device is pocket-sized (smart card) (see fig.1).

Re claim 9, wherein the portable consumer device is a smart card, and wherein the portable consumer device further comprises a microprocessor coupled to the body. (see figure 2).

Re claims 10-15, 17, 19, Drupsteen is capable of performing these method steps.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen. The teachings of Drupsteen has been discussed above.

Drupsteen fails to disclose or fairly suggests a plastic body including embossed region with customer identification. However, such characteristic are common in the art for producing smart/credit/memory cards.

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It would have been obvious for a person of ordinary skill in the art at the time the invention was made to manufacture the cards of Drupsteen with a plastic body and having embossing characters for the identifying the users. Such modification would make the card more sturdy and more secured by providing embossing characters, such as the user name, to identify the users. Therefore, it would have been an obvious extension as taught by Drupsteen.

6. Claims 5, 8, 16, 18, 20-29, 32, 38, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen in view of Johnsen, US Patent No. 5,250,789. The teachings of Drupsteen have been discussed above.

Drupsteen fails to disclose or fairly suggests that the system is used in a shopping establishment wherein the card includes a UPC code for identifying and associating each user with specific product and providing reward (promotional products) to a customer based on the products purchased.

Johnsen disclose a shopping cart comprising: a scanner 22, the scanner 22 is used at the beginning of a shopping visit to scan an identification card 52 provided to each shopper, the identification card 52 is provided with a bar code symbol 54 which is unique to any particular shopper, as products are scanned by scanner 22, some or all products may be used to trigger a promotional advertisement or an in-store coupon on the display screen 14; a store computer in communication with the display system 10 or a database which has been input into the display system 10 through the floppy disk drive 18 may be provided with a table of advertisements and coupon offers or rebate information each responsive to a particular product as it is being selected and scanned by a customer, the advertisements and coupons provided to a customer are

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geared towards the customer's perceived needs or interests as indicated by the products which are being selected. (see figures 1, 3, 4; and col. 6, line 16+).

It would have been obvious for a person of ordinary skill in the art at the time the invention was made to employ the system of Drupsteen in conjunction with the system of Johnsen for performing financial transactions. Such combined system would be more effective wherein each customer could be easily tracked and associated with specific products and would be more convenient by providing alternate means, such bar code symbol) to identify each customer. Therefore, it would have been obvious to an ordinary artisan in the art.

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drupsteen in conjunction with Johnsen, in view of Allard et al, US patent No. 6,249,773. The teachings of Drupsteen in conjunction with Johnsen have been discussed above.

Drupsteen in conjunction with Johnsen fail to disclose or fairly suggest an Internet connection.

Allard et al disclose an electronic commerce with shopping list builder which includes Internet connection means for communicating to administration tool site and the store database (see col. 4, line 28+).

In view of Allard et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Drupsteen in conjunction with Johnsen to include Internet connection means. Such modification would make the system more effective wherein customers would be able to access information about selected products and to compare different available products in order to make more informed selections.

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Therefore, it would have been an obvious extension as taught by Drupsteen in conjunction with Johnsen.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shepley, US Patent No. 6,024,281.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

DS  
December 10, 2004

A handwritten signature in black ink, appearing to read "Daniel St.Cyr", is written over a horizontal line. The signature is fluid and cursive, with a large, stylized 'S' and 'C'.